

### **REMARKS**

This is a full and timely response to the Office Action of August 26, 2004. Reexamination, reconsideration, and allowance of the application and all presently pending claims are respectfully requested.

Upon entry of this Second Response, claims 1-24 and 26-29 are pending in this application. Claims 1-17, 19-24, and 26-29 have been directly amended herein, and claim 25 has been canceled without prejudice or disclaimer. It is believed that the foregoing amendments add no new matter to the present application. Entry of the foregoing amendments is respectfully requested pursuant to 37 C.F.R. §1.116.

### **Response to §103 Rejections**

In order for a claim to be properly rejected under 35 U.S.C. §103, the combined teachings of the prior art references must suggest all features of the claimed invention to one of ordinary skill in the art. See, *e.g.*, *In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981). In addition, “(t)he PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (Citations omitted).

## Claim 1

Claim 1 presently stands rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Grube* (U.S. Patent No. 5,666,661) in view of *Elliot* (U.S. Patent No. 6,456,599). Claim 1 reads as follows:

1. ***A portable cellular telephone***, comprising:  
an antenna; and  
control logic configured to monitor cellular signals detected by said antenna, ***a plurality of said cellular signals transmitted from remote cellular devices directly to said antenna, said plurality of cellular signals including unique identifiers of said remote cellular devices***, said control logic further configured to store said unique identifiers and to receive a request to transmit to a remote cellular device and ***to make a determination, in response to said request, as to whether a unique identifier of said remote cellular device is stored in said portable cellular telephone***, said control logic further configured to transmit a cellular signal based on said determination. (Emphasis added).

Applicant respectfully submits that the cited art fails to suggest at least the features of claim 1 highlighted above. Thus, the 35 U.S.C. §103 of claim 1 is improper.

In rejecting claim 1, it is alleged in the Office Action that *Grube* suggests “communication units or cellular devices at different locations or coverage areas initiate a communication by transmitting an identification code; *col. 2, lines 44-47; Fig. 1, item 120, 113, and 114*).” Indeed, Fig. 1 of *Grube* shows a message 119 having an ID code 120 that apparently identifies a “communication unit (102, 103)” and that is transmitted from one “communication unit (102, 103).” However, there is nothing to suggest that such a message 119 is communicated from one “communication unit (102, 103)” ***directly*** to another. In this regard, it appears that the message 119 is transmitted from a “communication unit (102, 103)” to a resource controller 101, which apparently resides at a base station and not in any of the “communication units (102, 103).” See Fig. 1 and column 2, lines 37-40.

*Grube* does, however, suggest an embodiment in which communication mode selection is made by a “communication unit (102, 103)” rather than a resource controller 101

at a base station. See column 3, line 53, through column 4, line 9. However, in such an embodiment, signals used to initiate a communication session between any two “communication units (102, 103)” do not appear to be communicated *directly* between such “communication units (102, 103).” Instead, it appears that such signals are communicated from one “communication unit (102, 103)” to another through a base station.

In this regard, *Grube* specifically teaches that communication is switched to the “direct” or “new” mode in block 307 *after* an “acknowledgement” is transmitted in block 306. Thus, the “acknowledgement” as well as previously communicated signals of *Grube*, such as the message 119 referenced at column 2, lines 44-47, do not appear to be transmitted “directly” between “communication units (102, 103).” Instead, such previously communicated signals appear to be transmitted in a non-direct mode, which presumably includes the use of one or more base stations.

Accordingly, the Office Action fails to establish that any of the alleged “plurality of cellular signals” of *Grube* are transmitted *directly* between “communication units (102, 103),” and the Office Action, therefore, fails to establish a *prima facie* case of obviousness with respect to at least the features of claim 1 highlighted hereinabove. In particular, the Office Action fails to establish that the alleged “plurality of signals” are “transmitted from remote cellular devices *directly* to said antenna” of a “portable cellular telephone,” as recited by claim 1. (Emphasis added). Further, the Office Action fails to allege that the foregoing deficiency of *Grube* is overcome by *Elliot*.

For at least the above reasons, Applicant respectfully submits that the cited art fails to suggest each feature of claim 1, and the 35 U.S.C. §103 rejection of claim 1 should, therefore, be withdrawn.

### **Improper Combination**

The Patent Office can satisfy its burden of establishing a *prima facie* case of obviousness “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Applicant respectfully submits that the Office Action fails to provide an adequate motivation for combining *Grube* and *Elliot*, and the 35 U.S.C. §103 rejection of claim 1 is, therefore, improper.

In rejecting claim 1, it is asserted in the Office Action that:

“it would have been obvious to one with ordinary skill in the art at the time the invention was made to have Grube et al. Direct mode communication system to include a table for storing unique identifiers and make a determination thereof, as taught by Elliot for the purpose of ***providing awareness to a communication device of those devices who are in a relative close range.***” (Emphasis added).

Applicant observes that the combination of *Elliot* with *Grube* is not needed to provide “awareness to a communication device of those devices who are in a relative close communication range.” In this regard, *Grube* appears to provide such functionality based on the geographic separation between communication units. See column 2, lines 44-67. Further, there is no cited deficiency in the techniques described by *Grube* that would motivate one of ordinary skill in the art to seek solutions taught in *Elliot*. Moreover, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349, 53 U.S.P.Q.2d 1580 (Fed. Cir. January 27, 2000).

For at least the foregoing reasons, Applicant respectfully asserts that the Office Action fails to establish a sufficient motivation for combining *Grube* and *Elliot*, and such combination under 35 U.S.C. §103 is, therefore, improper. “Our case law makes clear that

the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application for a showing of the teaching or motivation to combine prior art references.” *In re Dembiczak*, 175 F.3d 994, 50 U.S. P.Q.2d 1614, 1617 (Fed. Cir. 1999). Accordingly, Applicant respectfully requests that the 35 U.S.C. §103 rejection of claim 1 be withdrawn.

### **Teaches Away**

*Elliot* teaches techniques for routing information more efficiently between network nodes. However, *Elliot* specifically teaches that such techniques are to be implemented within nodes of an “ad hoc network.” See title, column 1, line 12, and column 4, line 8. There is nothing in the cited art to suggest that a “cellular telephone,” as described by claim 1, constitutes a node of an “ad hoc network.” Thus, when *Elliot* is properly viewed as a whole, including those teachings that diverge from the claimed invention, it is apparent that the combination of *Elliot* with *Grube* to reject the present invention, as defined by pending claim 1, is improper. “(P)rior art references before the tribunal must be read as a whole and consideration must be given where the references diverge and teach away from the claimed invention.” *Akzo N.V. v. U.S. Intern’l Trade Com’n*, 808 F.2d 1471, 1481, 1 U.S.P.Q.2d 1291 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909.

### **Claims 2-7, 24 and 26-29**

Claims 1, 3-7, 24, and 27 presently stand rejected in the Office Action under 35 U.S.C. §103 as allegedly being unpatentable over *Grube* in view of *Elliot*. Further, claim 4 presently stands rejected under 35 U.S.C. §103 as unpatentable over *Grube*, and claim 2 presently stands rejected under 35 U.S.C. §103 as unpatentable over *Grube* in view of *Elliot* and in further view of *Aarnio* (U.S. Patent No. 6,522,889). In addition, claims 26, 28, and 29

presently stand rejected in the Office Action under 35 U.S.C. §103 as allegedly being unpatentable over *Grube* in view of *Elliot* and in further view of *Carro* (U.S. Patent No. 6,580,909). Applicant submits that the pending dependent claims 2-7 and 24-29 contain all features of their respective independent claim 1. Since claim 1 should be allowed, as argued hereinabove, pending dependent claims 2-7 and 24-29 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

### **Claim 8**

Claim 8 is rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Grube* in view of *Elliot*. For at least the reasons set forth hereinabove in the arguments for allowance of claim 1, Applicant respectfully asserts that the combination of *Grube* and *Elliot* to reject claim 8 under 35 U.S.C. §103 is improper. Accordingly, the 35 U.S.C. §103 rejection of claim 8 should be withdrawn.

### **Claims 9-15**

Claim 9 presently stands rejected under 35 U.S.C. §103 as unpatentable over *Grube* in view of *Elliot* and in further view of *Aarnio*, and claims 10-15 presently stand rejected in the Office Action under 35 U.S.C. §103 as allegedly being unpatentable over *Grube* in view of *Elliot*. Applicant submits that the pending dependent claims 9-15 contain all features of their respective independent claim 8. Since claim 8 should be allowed, as argued hereinabove, pending dependent claims 9-15 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

### Claim 16

Claim 16 is rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Grube* in view of *Elliot*. Claim 16 reads as follows:

16. A cellular transmission method, comprising the steps of:  
***monitoring a plurality of cellular signals transmitted directly from remote cellular devices to an antenna of a portable cellular telephone said signals including unique identifiers of said remote cellular devices;***  
storing said unique identifiers of said remote cellular devices;  
detecting a transmission request at said cellular telephone;  
***determining, in response to said detecting step, whether a unique identifier of said remote cellular device is stored in said cellular telephone;*** and  
transmitting, based on said determining step, a cellular signal from said cellular telephone to said remote cellular communication device identified by said transmission request.. (Emphasis added).

For at least the reasons set forth hereinabove in the arguments for allowance of claim 1, Applicant respectfully asserts that the cited art fails to suggest at least the features of claim 16 highlighted above, and the combination of *Grube* and *Elliot* is improper. Accordingly, the 35 U.S.C. §103 rejection of claim 16 should be withdrawn.

### Claims 17-19

Claims 17 and 18 presently stand rejected in the Office Action under 35 U.S.C. §103 as allegedly being unpatentable over *Grube* in view of *Elliot*, and claim 19 presently stands rejected under 35 U.S.C. §103 as purportedly unpatentable over *Grube* in view of *Elliot* and in further view of *Aarnio*. Applicant submits that the pending dependent claims 17-19 contain all features of their respective independent claim 16. Since claim 16 should be allowed, as argued hereinabove, pending dependent claims 17-19 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

### **Claim 20**

Claim 20 is rejected under 35 U.S.C. §103 as allegedly being unpatentable over *Grube* in view of *Elliot*. For at least the reasons set forth hereinabove in the arguments for allowance of claim 1, Applicant respectfully asserts that the combination of *Grube* and *Elliot* to reject claim 20 under 35 U.S.C. §103 is improper. Accordingly, the 35 U.S.C. §103 rejection of claim 20 should be withdrawn.

### **Claims 21-23**

Claims 21 and 23 presently stand rejected in the Office Action under 35 U.S.C. §103 as allegedly being unpatentable over *Grube* in view of *Elliot*, and claim 22 presently stands rejected under 35 U.S.C. §103 as purportedly unpatentable over *Grube* in view of *Elliot* and in further view of *Aarnio*. Applicant submits that the pending dependent claims 21-23 contain all features of their respective independent claim 20. Since claim 20 should be allowed, as argued hereinabove, pending dependent claims 21-23 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).



### **CONCLUSION**

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted,

**THOMAS, KAYDEN, HORSTEMEYER &  
RISLEY, L.L.P.**

By:



Jon E. Holland  
Reg. No. 41,077  
(256) 704-3900

Hewlett-Packard Development Company, L.P.  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, Colorado 80527-2400